



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE

United States Patent and Trademark Office

Address: COMMISSIONER FOR PATENTS

P.O. Box 1450

Alexandria, Virginia 22313-1450

www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/530,759	06/23/2005	Eva-Maria Leppanen	59643.00602	9073
32294 7590 12/24/2008 SQUIRE, SANDERS & DEMPSEY L.L.P. 8000 TOWERS CRESCENT DRIVE 14TH FLOOR VIENNA, VA 22182-6212				
EXAMINER RICKET, JASON D				
ART UNIT		PAPER NUMBER		
2442				
MAIL DATE		DELIVERY MODE		
12/24/2008		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary**Application No.**

10/530,759

Applicant(s)

LEPPANEN ET AL.

Examiner

JASON RECEK

Art Unit

2442

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 September 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-31 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-31 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/CDC)
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date: _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____
- Paper No(s)/Mail Date: _____

DETAILED ACTION

This is in response to the amendment filed on September 22nd 2008.

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 9/22/08 has been entered.

Status of Claims

Claims 1-31 are pending.

Claim 14 is currently objected to.

Claims 1-17 and 21-31 are currently rejected under 35 U.S.C. 102(e).

Claims 18-20 are currently rejected under 35 U.S.C. 103(a).

Response to Arguments

2. Applicant's arguments filed 9/22/08 have been fully considered but they are not persuasive.

Applicant argues that Agrawal fails to disclose all of the elements of the claims and specifically "said provided information defines a subset of said elements of said presence information" as recited by independent claim 1. This argument is not persuasive. Agrawal explicitly discloses that user presence data is configured (paragraph 41). The word configure is generally understood in the art to mean adapt for a specific situation. Thus Agrawal is teaching that the presence information is selected from what is available (configured). Since Agrawal uses the term "can be" it is clear from the disclosure that it does not require all of the presence information to be sent but rather Agrawal discloses sending anywhere from zero to all of the presence information depending on the configuration. Applicant's assertion that Agrawal contains no teaching that only certain elements of the presence information should be provided (pg. 14) does not flow from the disclosure of Agrawal. In fact it seems to be in stark contrast. Agrawal does not teach to send all of the presence information to each user. Rather Agrawal teaches configuring presence information for a specific use (paragraph 41). Agrawal also clearly discloses that a user can control their own presence information (paragraph 49), thus providing only a subset of that information to other users if they so choose. For at least these reasons and the detailed rejection below applicant's argument is not persuasive.

Applicant also argues that Requena does not qualify as prior art (pg. 15). This argument is not persuasive. Requena is a divisional application which claims priority to application 10/023,456 filed on 10/30/2001, now US PUB 2002/0126701. Applicant should be aware that the MPEP allows applications to claim priority to a previously filed application. See MPEP 1504.20 and 35 U.S.C. 120.

Claim Objections

3. Claim14 is objected to because of the following informalities: the phrase "as to subsets of said *the* elements" is unclear, the word *the* should be removed. Appropriate correction is required.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 1-17 and 21-31 are rejected under 35 U.S.C. 102(e) as being anticipated by Agrawal US 2002/0083127 A1.

Regarding claim 1, Agrawal discloses "a presence information unit configured to provide presence information" as a presence server that contains presence information about users (pg. 2 paragraph 24, Fig. 1), "said presence information comprising a plurality of elements" as presence data may indicate multiple conditions (pg. 2 paragraph 25), "a storing unit configured to store information defining at least one group, said group containing a plurality of users" as a buddy list (pg.2 paragraph 26), "an information providing unit configured to provide information defining for each user of said group which elements of said presence information are to be provided to at least one user" as configuring user presence data to indicate specific states for certain users (pg. 4 paragraphs 41, 49), and "said provided information defines a subset of said elements of said presence information" as providing certain presence information but not all presence information (paragraphs 41, 49).

Regarding claim 2, Agrawal discloses "said defined subsets of said presence information are provided to a requester in response to request from said requester" as providing presence data from the server to the client (pg. 3 paragraph 39, Fig. 4).

Regarding claim 3, Agrawal discloses "wherein said requester is at least one of said plurality of said users" as a user who configures their buddy list to show presence data of others is a requester of that data (pg. 2 paragraph 26).

Regarding claim 4, Agrawal discloses "said defined subsets of said elements of said presence information are available only to one requester or to a plurality of requesters" as controlling who has access to presence information (pg. 4 paragraph 49).

Regarding claim 5, Agrawal discloses "said defined subsets of said elements of said information provided are dependent on the identity of the requester" as only showing presence information to certain people (pg. 4 paragraph 49).

Regarding claim 6, Agrawal discloses "a determining unit configured to determine the identity of the requester making said request" as a buddy list user would necessary know the identity of the other users receiving the presence information (pg. 4 paragraph 41).

Regarding claim 7, Agrawal discloses "said storing unit comprises a presence server" as a presence server (pg. 2 paragraph 24, Fig. 1).

Regarding claim 8, Agrawal discloses "said information providing unit ... comprises a storage means" as an application server having a presence repository (pg. 4 paragraph 42, Fig. 11).

Regarding claim 9, Agrawal discloses "said storing unit and said information providing unit are provided by a common storage unit" as a presence server and an application server that have access to a common presence repository (pg. 4 paragraph 41-42, pg. 5 paragraph 53, Fig. 11).

Regarding claim 10, Agrawal discloses "said information providing unit ... comprises one of said users" as a user that provides presence information about himself (pg. 4 paragraph 49).

Regarding claim 11, Agrawal discloses "a separate address is provided for each of a plurality of groups" as using protocols HDTP/HDML or WAP or TCP/IP each message would have a unique address, thus each group would have a separate address (pg. 2 paragraph 27-9).

Regarding claim 12, Agrawal discloses "said users comprise user equipment" as a client/user consisting of a mobile device (pg. 2 paragraph 24, Fig. 1).

Regarding claim 13, Agrawal discloses "said presence information comprises at least one of the following elements of information: Subscriber status; Network status; communication means; Contact address, Subscriber provided location; Network provided location; text; priority; mood, favourite colour" as presence information includes

at least network status – available or unavailable (pg. 2 paragraph 25) but may also include contact information and location (pg. 4 paragraph 41).

Regarding claim 14, Agrawal discloses “second information comprises information as to subsets of said the elements of said presence information” as providing the presence information requested (pg. 2 paragraph 25, pg. 3 paragraph 39) which is configured from available presence information (paragraph 41), thus comprising a subset of information.

Regarding claim 15, Agrawal discloses “second information comprises information as to the subsets of said elements of said presence information not required” as providing more information than simply available or unavailable but also providing whether a user is available by cell phone, this information will often not be required for purposes of deciding whether a user is available to receive a message (pg. 4 paragraph 41, 48).

Regarding claim 16, Agrawal discloses “the subsets of said elements of the presence information to be obtained are the same for all of at least one group” as configuring a buddy list to identify who is available, thus the same information is provided for all of the group (pg. 4 paragraph 41).

Regarding claim 17, Agrawal discloses "the subsets of said elements of the presence information to be obtained are different for at least two users at least one group" as configuring a buddy list to identify who is available and configuring a buddy list to identify who is not available but reachable, thus different presence information is being obtained (pg. 4 paragraph 41).

Regarding claim 21, Agrawal discloses "said storing unit is arranged to receive presence information from the users of said group" as presence information is sent from the users to the server where it is stored (pg. 2 paragraph 25).

Regarding claim 22, Agrawal discloses "said storing unit is arranged to provide the parts of the presence information to be provided" as the server provides the presence information to other users (pg. 4 paragraph 41).

Regarding claims 23-24, Agrawal discloses "an entity associated with a user or a user of the group is arranged to provide to the elements of the presence information to be provided" and "said entity comprises a presence server" as a presence server associated with the users that provides presence information (pg. 2 paragraph 24, Fig. 1).

Regarding claim 25, Agrawal discloses "said storing unit is configured to add said elements of presence information to a request sent to said user or an entity associated

with said user" as delivering an acknowledgment to the message originator concerning the user presence information (pg. 4 paragraph 44).

Regarding claim 26, Agrawal discloses "said storage unit receives from said requester, said storage unit is configured to insert the elements of presence information into a request sent to said user or an entity associated with said user" as an application where a user configures a buddy list to inform user presence data, thus the storage means is inserting the user presence data for the requester (pg. 2 paragraph 26, pg. 3 paragraph 39, pg. 4 paragraph 41).

Regarding claim 27, Agrawal discloses "defining at least one group containing a plurality of users with which presence information is associated, said presence information comprising a plurality of elements associated with each user" as a buddy list where users have presence information associated with them that comprises a plurality of parts (pg. 2 paragraph 26, pg. 4 paragraph 41), and "defining for each user of said group what elements of said presence information are to be provided, wherein ... said provided information defines a subset of said elements" as specifying what presence information to receive (pg. 4 paragraph 41).

Regarding claim 28, Agrawal discloses "filtering the presence information for at least one user of the group to obtain the defined elements of said presence information"

as a user configuring what presence information to show and to whom, thus the presence information is "filtered" (pg. 4 paragraph 49).

Regarding claim 29, Agrawal discloses "requesting for at least one user of said group said defined elements of said presence information" as a user wanting to know the presence information of another user of a group (pg. 3 paragraph 39).

Regarding claim 30, Agrawal discloses "a storing unit ... defining at least one group, wherein said group comprises a plurality of users with which presence information is associated" as a buddy list that contains several users each user having presence information (pg. 2 paragraph 26), "said presence information comprises a plurality of elements" as presence information that comprises multiple parts (pg. 2 paragraph 25, pg. 4 paragraph 41), and "second information defining for each user of said group which elements of said presence information are to be provided, wherein ... provided information defines a subset of said elements" as a user configuring what parts of presence information to provide (pg. 4 paragraphs 41, 49).

Regarding claim 31, it corresponds to claim 1 except it contains the language "means for" in place of the term "unit" thus it is narrower in scope since it is limited to the examples described in the specification and therefore it is rejected for the same reasons given in claim 1.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 18-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Agrawal in view of Requena US 2007/0124471 A1.

Regarding claim 18, Agrawal does not disclose "the system operates in accordance with a session initiation protocol (SIP)" however this is taught by Requena as a presence information system that uses SIP (pg. 5 paragraph 73, pg. 13 paragraph 180-4, Fig. 11-2).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Agrawal with the SIP message SUBSCRIBE taught by Requena. The motivation for using SIP is that SIP carries presence information which is the object of the invention, thus it would be natural to use SIP for the purpose of operating the system.

Regarding claim 19, Agrawal does not disclose "request for said presence information is made in a SUBSCRIBE request" however this is taught by Requena as a SUBSCRIBE request (pg. 13 paragraph 183, Fig. 11).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Agrawal with the SIP message SUBSCRIBE taught by Requena. The motivation for using SIP is that SIP carries presence information which is the object of the invention, thus it would be natural to use SIP for the purpose of operating the system.

Regarding claim 20, Agrawal does not disclose "the information providing unit comprises a SIP SUBSCRIBE message" however this is taught by Requena as a SUBSCRIBE message sent to the SIP server (pg. 13 paragraph 183, Fig. 11).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Agrawal with the SIP message SUBSCRIBE taught by Requena. The motivation for using SIP is that SIP carries presence information which is the object of the invention, thus it would be natural to use SIP for the purpose of operating the system.

Conclusion

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Lonnfors et al. US 2004/0177134 A1 discloses using a subset of the complete set of presence information (paragraph 16).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JASON RECEK whose telephone number is (571)270-1975. The examiner can normally be reached on Mon - Thurs 8:30am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Caldwell can be reached on (571) 272-3868. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Andrew Caldwell/
Supervisory Patent Examiner, Art
Unit 2442

/Jason Recek/
Examiner, Art Unit 2442
(571)-270-1975